

### **Remarks**

Applicants have amended claims 1, 4, 21, 23 and 26 and added new dependent claims 27-37 as shown above and discussed below. Support for the amendments and new claims may be found at, e.g., paragraphs 0018, 0021-0023, 0025, 0026 and 0032-0034. Objected-to claims 9, 11 and 12 have been rewritten in independent form. Following entry of this amendment, claims 1, 2, 4 and 6-37 will be pending in this application.

Applicants thank the Examiner for promptly responding to applicants' April 11 amendment, and for making the new rejections non-final so that applicants would have a further opportunity to respond.

### **Rejection of claims 1, 2, 4, 6 to 8, 10, 13 to 23 and 26 under 35 U.S.C. §102 and §103**

Claims 1, 2, 4, 6 to 8, 10, 13 to 23 and 26 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 4,393,121 (Tobias et al.), on grounds recited at pages 2-4 of the Office Action. Reconsideration is requested.

As to the §102(b) rejection of claims 1, 2, 4, 6 to 8, 10 and 13 to 23, applicants have amended independent claims 1, 21 and 23 to change the phrase "between about 50 and 75" (for the weight percent isophthalic acid based on the total weight of resin) to "between 50 and 75". The phrase "between 50 and 75" would not read on Tobias et al.'s cited 48% upper disclosed isophthalic acid amount (see e.g., col. 1, lines 25-26 and 46-49) or cited 46.6% Example 1 isophthalic acid amount. This amendment should overcome the §102(b) rejection of claims 1, 2, 4, 6 to 8, 10, 13 to 23 over Tobias et al. and applicants accordingly request its withdrawal as to those claims.

As to the §103(a) rejection of claims 1, 2, 4, 6 to 8, 10 and 13 to 23, the appropriate standard is not whether one skilled in the art "would have expected" the claimed compositions and the cited Tobias et al. compositions "to have the same properties". MPEP §2142.02 says that "In determining the differences between the prior art and the claims, the question under

35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious” (emphasis in original). MPEP §2142.02 also says that “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis in original). Tobias et al. do not provide a proper basis for making a coated substrate “wherein the coating composition comprises a binder comprising a polyester resin that ... comprises between about 50 and 75 weight percent isophthalic acid based on the total weight of resin” as recited in applicants’ rejected claims. Tobias et al. say at col. 1, lines 46-49 that “The amount of isophthalic acid component used is between about 40 weight percent and about 48 weight percent, based upon the total weight of the reactants.” Tobias et al use two significant figures for the latter value, and say “about 48” and not “about 49” or “about 50”. If asked to consider the matter, a person having ordinary skill in the art who reviewed Tobias et al. would conclude that the isophthalic acid amount should not be more than Tobias et al.’s recited “about 48” upper limit and would not be motivated to use a larger amount.

The separately-cited U.S. Patent No. 5,739,204 (Piana, discussed below) recites several desired properties for polyester protective coatings (see e.g., col. 1, lines 15-20), and says at col. 1, lines 20-21 that “It is difficult to achieve an optimum for all of these properties, as the improvement of one property is in most cases at the expense of the others.” Piana also says at col. 1, lines 29-33 that “The hardness can be achieved, for example, by the incorporation of a high proportion of cyclic, in particular aromatic, dicarboxylic acids into the polyester. However, this causes the protective coatings to become brittle and fragile.” This provides a further reason why a person having ordinary skill in the art who reviewed Tobias et al. would not use more than Tobias et al.’s recited “about 48” upper limit for the amount of isophthalic acid.

Applicants thus request withdrawal of the §103(a) rejection of claims 1, 2, 4, 6 to 8, 10 and 13 to 23 over Tobias et al.

As to independent claim 26, Tobias et al. does not show or suggest a substrate coated with a polyester resin coating composition formed using greater than 85 weight percent isophthalic acid based on the total weight of acids. Applicants thus request withdrawal of the

§§102(b)/103(a) rejections of claim 26 over Tobias et al.

Concerning the rejected dependent claims, applicants rely on their arguments shown above to address the rejections of claims 2, 6 to 8, 10 and 13 to 18.

As to dependent claim 4, applicants have amended this claim to change the phrase “greater than about 85 weight percent” (for the amount of aromatic dicarboxylic acid component based on the total weight of acid) to recite “greater than 85 weight percent”. The phrase “greater than 85 weight percent” would not read on Tobias et al.’s cited 81 weight percent Example 1 isophthalic acid amount. Applicants do not agree with the Office Action’s page 4 assertion that the “total amount of isophthalic acid as determined from column 1, lines 20 to 25 clearly embraces values above 85 wt%”. The cited Tobias et al. passage says to use “10-16 weight percent adipic acid” and “40-48 weight percent isophthalic acid”. The highest proportion of isophthalic acid in a mixture of such acids would be 48 parts isophthalic acid and 10 parts adipic acid, or 83 weight percent isophthalic acid based on the total weight of acid.

As to dependent claims 19 and 20, applicants rely on their arguments shown above and add that Tobias et al. do not show or suggest a coated substrate “wherein the coating has a flexibility of 0T with no tape off” as recited in claim 19 or a coated substrate “wherein the coating composition when formulated to an initial white color and exposed outdoors in South Florida for 17 months at a 45 degree angle facing south, has an L value color change less than about 3 units compared to an unexposed panel” as recited in claim 20.

Applicants accordingly request withdrawal of the §§102(b)/103(a) rejections of claims 1, 2, 4, 6 to 8, 10, 13 to 23 and 26 over Tobias et al.

**Rejection of claims 1, 2, 4, 8, 10, 13 to 15, 19,****20 to 23 and 26 under 35 U.S.C. §103**

Claims 1, 2, 4, 8, 10, 13 to 15, 19, 20 to 23 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Piana, on grounds recited at pages 4-5 of the Office Action. Reconsideration is requested.

As to claims 1, 2, 4, 8, 10, 13 to 15, 19 and 20 to 23, applicants rely on the citations and arguments provided above concerning MPEP §2142.02 and its requirements. Applicants add that Piana's cited Table 1, Composition A10 is one of Piana's Comparative Examples and the coating compositions made from them are Comparative Formulations (see e.g., col. 6, lines 40-44 and col. 7, lines 14-19). The Comparative Formulation made from Composition A10 (*viz.*, Formulation B10 in Table 3) was tested alongside the other working example formulations and comparative example formulations with results shown in Piana's Table 4. The cured coating made from Comparative Formulation B10/Comparative Example C10 was evaluated only for initial gloss and not for weathering. It exhibited the lowest measured 20°, 60° and 80° initial gloss values shown in Table 4. If asked to consider the matter, a person having ordinary skill in the art would regard Comparison Example C10 as inferior and would not have any proper basis for modifying Comparison Example C10 to make a coated substrate "wherein the coating composition comprises a binder comprising a polyester resin that is formed using ... at least one asymmetric diol in an amount greater than 20 weight percent based on the total weight of polyols".

Applicants add that the compositions in Piana's working Examples 1-8 do not contain asymmetric diols. Piana does not discuss diol symmetry or distinguish between symmetric and asymmetric diols. A person having ordinary skill in the art who reviewed Piana would have no basis for making a substrate coated with a polyester resin coating composition formed "using polyols comprising at least one symmetric diol in an amount greater than 50 weight percent based on the total weight of polyols and at least one asymmetric diol in an amount greater than 20 weight percent based on the total weight of polyols" as recited in applicants' rejected claims 1, 2, 4, 8, 10, 13 to 15, 19 and 20 to 23. Applicants thus request withdrawal of the §103(a) rejection of claims 1, 2, 4, 8, 10, 13 to 15, 19 and 20 to 23 over Piana.

As to claim 26, Piana does not show or suggest a substrate coated with a polyester resin coating composition formed using polyols comprising "at least one asymmetric diol in an amount greater than 25 weight percent based on the total weight of polyols". Applicants thus request withdrawal of the §103(a) rejection of claim 26 over Piana.

Applicants accordingly request withdrawal of the §103(a) rejection of claims 1, 2, 4, 6 to 8, 10, 13 to 23 and 26 over Piana.

### **Claims 9, 11 and 12**

As recommended at page 5 of the Office Action, claims 9, 11 and 12 have been rewritten in independent form to include all of the limitations of the base claim and any intervening claims. These claims should now be allowable.

### **Conclusion**

Applicants have made an earnest effort to address the rejections. Withdrawal of the rejections and passage of the application to the issue branch are accordingly requested. The Examiner is encouraged to telephone the undersigned attorney if there any questions regarding the application or this amendment.

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IPLM Group, P.A.  
P.O. Box 18455  
Minneapolis, MN 55418

Respectfully submitted on behalf of  
Valspar Sourcing, Inc.,



David R. Cleveland  
Registration No: 29,524  
612-331-7412 (telephone)  
612-331-7401 (facsimile)  
Customer No. 23322